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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------------|-------------|----------------------|-------------------------|------------------|
| 10/032,939 | 12/26/2001 | James Hong | ACS 57804 (3002X) | 7863 |
| 24201 | 7590 | 02/12/2004 | EXAMINER | |
| FULWIDER PATTON LEE & UTECHT, LLP | | | PHAN, HIEU | |
| HOWARD HUGHES CENTER | | | ART UNIT | PAPER NUMBER |
| 6060 CENTER DRIVE | | | 3738 | |
| TENTH FLOOR | | | DATE MAILED: 02/12/2004 | |
| LOS ANGELES, CA 90045 | | | 8 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 10/032,939 | Applicant(s) HONG ET AL. |
|------------------------------|-------------------------------|-----------------------------|
| | Examiner | Art Unit |
| | Hieu Phan | 3738 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
 - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 November 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-37 is/are pending in the application.
4a) Of the above claim(s) 4, 6, 11, 14, 19-21, 23-29, 36 and 37 is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-3, 7, 8, 17 and 30 is/are rejected.
7) Claim(s) 5, 9, 10, 12, 13, 15-18, 22 and 31-35 is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) Other: _____

Response to Election/Restriction

1. Applicant's election with traverse of Specie 1, claims 1-3, 5, 7-10, 12, 13, 15-18, 22 and 30-35 and figures 1-7, in Paper No. 5 is acknowledged. Furthermore, examiner acknowledges claims 1, 17 and 30 are generic. Claims 4, 6, 11, 14, 19-21, 23-29, 36 and 37 are withdrawn from consideration. The traversal is on the ground(s) that it is not a burden on the examiner to search disclosed independent distinct species. This is not found persuasive because it is a burden for the examiner to search for more than one specie. In this case, applicant claims 5 independent distinct species.

The requirement is still deemed proper and is therefore made FINAL.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-3, 7, 8, 17 and 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 5-8 of

U.S. Patent No. 6,565,599. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-3, 7, 8, 17 and 30 of the application recite the same inventive intravascular stent as is the claims 1-3 and 5-8 of U.S. Patent No. 6,565,599. All the claims in both application and patent call for an inventive intravascular stent with metal rings and polymeric links. The remaining specific structural limitations, can either be said to have been obviously implied by equivalent language in the claims of the patent.

Allowable Subject Matter

4. Claims 5, 9, 10, 12, 13, 15-18, 22 and 31-35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hieu Phan whose telephone number is 703-308-8969. The examiner can normally be reached on Monday-Friday from 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M McDermott can be reached on 703-308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0873.

Hieu Phan
Examiner
Art Unit 3738

H. P.

CZ
CORRINE McDERMOTT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700